

REMARKS

Restriction

Claims 1-59 are pending in this application and have been subjected to restriction under 35 U.S.C. § 121 and 372 because, in the Examiner's opinion, as set forth in the Detailed Action, the application contains both product and process claims, which claims are not so linked as to form a single general inventive concept under PCT Rule 13.1. Applicants disagree, and accordingly traverse the Examiner's restriction requirement.

The Examiner determined that there were two groups of claims subject to the restriction requirement:

- Group I: Claims 1-33 and 35-59, drawn to compositions, and
- Group II: Claim 34, drawn to a method for imparting a volumizing effect.

Applicants provisionally elect **Group I with traverse**, including claims 1-33 and 33-59 for prosecution. Applicants respectfully disagree with the restriction requirement imposed by the Examiner and the characterizations made of the claimed invention.

It is the Examiner's position that restriction is appropriate because inventions of Groups I and II lack unity of invention because the claims in these groups fail to express special technical features so as to "define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art so linked as to form a single general inventive concept." OA at page 2, last full paragraph. The Examiner determined that Claim 1 failed to define a contribution over the prior art because it lacks inventive step, citing US 6096702 ("Ramirez") in view of US 5389363 ("Snyder").

Applicants submit that all claims in the subject application are linked by shared special technical features that form a single general inventive concept; namely, a cosmetic composition that expands following application to a hair fiber, at least a portion of which then sets in such expanded state as a consequence of including a film forming agent in the composition.

Applicants further note that claim 34 is drawn to a method for imparting a volumizing effect characterized by the step of contacting the hair *with the composition of claim 2* for a time sufficient to obtain *said* volumizing effect. (Emphasis added.)

Claim 2 clearly describes *said* effect referred to in claim 34, as appears in italics below:

2. A *post-application expanding* cosmetically acceptable composition for *application to hair fibers* of the scalp, eyebrows or eyelashes comprising at least one surfactant, a solvent for the surfactant, a volatile agent in an amount effective to *swell the composition after application to the hair fibers*, and a film-forming agent, the film-forming agent being present in an amount effective to *form a film and, when the film sets, to fix at least a portion of the swelled composition in an expanded state*, the volatile agent being solubilized in the composition, and the volatile agent further being dispersed throughout the composition in nanometer sized droplets or generated in situ on the hair fibers prior to application to the hair fibers, whereby the composition is storable in a non-pressurized container. (Emphasis added.)

Applicants are at a loss to understand how these technical features are absent from the invention of claim 35, since the composition applied in claim 34 is the composition of claim 2.

The only technical feature that could arguably be said to be different is the step of contacting the hair. Applicants fail to understand how the absence of this

feature changes the general inventive concept when the inventions are considered as a whole and in light of the interrelatedness of claim 34 to claim 2.

Applicants further submit that Claim 1 (or claim 2) is patentable over Ramirez in view of Snyder. Ramirez discloses post foaming clear gels and solutions, which have cosmetic utility hair skin cleansers, hair shampoos, and shower gels. The Ramirez compositions are also useful in non-cosmetic utilities as household cleansers. The Examiner states that Ramirez "... does not teach a film forming agent in self foaming gel,..." OA at page 2, last full paragraph. The Examiner states that Snyder makes up this deficiency of the Ramirez reference.

Applicants submit that the practitioner of ordinary skill would not look at Snyder to resolve the deficiencies of Ramirez. Ramirez concerns cleansing compositions. The practitioner would understand that the cleansers of Ramirez are intended to be removed from the body following the cleansing process. Including a film former in the Ramirez compositions would be antithetical to the purpose of Ramirez. Moreover, the compositions of Snyder contain a high percentage of wax (5 to 455, as disclosed at col. 4, lines 35-41). Waxes have an anti-foam effect (Snyder would certainly not wish for his mascara to foam), as the practitioner in the cosmetics arts understands. Similarly, silicone oils, which are present in the exemplified compositions of Snyder, and which appears to be an important feature of the gel phase, are also known anti-foam agents. Thus, the practitioner must first modify Snyder before using it to modify Ramirez to achieve for the thus modified Ramirez composition a wholly new utility than what Ramirez discloses.

The purpose of the compositions and method of the present invention is to thicken the hair strand by enveloping the post foamed composition with a film forming polymer, thereby adding volume to the lash, to achieve a benefit not anticipated nor intended by Snyder. In this regard, the foamed structure of Applicants' compositions

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when on the hair, and in particular on a lash, are beneficially for the consumer light in weight, as compared to the conventional wax-containing mascars of Snyder.

Applicants respectfully request that the restriction requirement be withdrawn and all presented claims be examined on the merits.

Respectfully submitted,

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/Charles J. Zeller/

Charles J. Zeller, Esq.
Reg. No. 28,682
Avon Products, Inc.
Avon Place
Suffern, NY 10901
Phone (845) 369-2113
Fax (845) 369-2900